

### REMARKS

Responsive to a Notice of Non-Compliant Amendment requiring a copy of the claims, such copy is included herewith. No claims were amended, although in the previously filed non-compliant amendment, the first paragraph of the Remarks indicated that claims had been amended. Accordingly, applicants believe the response to place the amendments in compliance with all requirements of 37 CFR §1.121. Entry of the Response is respectfully requested.

Claims 1, 3 – 11, 13 – 16 and 20 – 25 remain in the application and stand rejected. Claims 2, 12 and 17 – 19 are previously canceled. No new matter has been added. Although this Amendment is being filed with the fee for an extension of time, the Commissioner is hereby authorized to charge any additional fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

The “examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.” MPEP 2164.04, last paragraph (emphasis original).

Claims 1, 3, 6, 9, 15, 16 and 20 – 22 are rejected as being unpatentable under 35 U.S.C. §103(a) over published U.S. patent application No. 2002/0118671 to Staples et al. in combination with U.S. Patent No. 5,619,555 to Fenton et al. Claims 4, 5, 7, 8, 10, 11, 13, 14 and 23 – 25 are rejected as being unpatentable under 35 U.S.C. §103(a) over Staples et al. and Fenton et al. in view of published U.S. patent application No. 2001/0026609 to Weinstein et al. The rejection is respectfully traversed.

The Office action asserts that Staples et al. shows “a remotely connected device communicating with said communications server (fig. 3A. 130); and a remote telephone (fig. 11.1110) connected to said public telephone network (fig. 11.115; **connected through the remote device**);” page 3, #7 (emphasis added).

“In the preferred embodiment, user communication device 130 comprises a remote client computer 112 coupled to a client modem 113 as shown in FIG. 5.” Paragraph 0126. So, the client computer 112 and physical user phone 90 of Staples et al. Figure 6 constitute a user communication device 130. Paragraph 0130. Likewise, the client computer 112, telephony

device 1110 and client modem 1113 of Staples et al. Figure 11 constitute a user communication device 130. Paragraph 0179.

Acknowledging that Staples et al. does not show this “remote telephone (fig. 11.1110)” “*directly* connected to said public telephone network” 150 the Office action relies on Fenton.

Page 4. Specifically, the Office action asserts that

Fenton discloses a pair of remote telephones (fig. 1.22 and 24) associated with and in the vicinity of remote devices in column 4, lines 55-59. The remote telephones are directly connected to public network, fig. 1.20. Fenton states the remote device and telephone are not directly connected, however there is no reasoning given why they could not be directly associated. Therefore **Fenton does not teach away** from the proposed modification of Staples which would result in the remote telephone directly connected to the public telephone network, as taught by Fenton and the remote device, as taught by Staples.

*Id*, (emphasis added). Neither does either Staples et al. or Fenton suggest such a proposed modification; nor does a straight forward combination of these two references result in the present invention as recited by claims 1, 3 – 11, 13 – 16 and 20 – 25.

“Client computer **112** may be coupled to a telephony device 1110. Telephony device 1110 may comprise a physical phone such as physical user phone 90 and/or a virtual phone such as virtual phone 94.” Staples et al. paragraph 0182 (emphasis added). A virtual phone would not be directly connected to anything without the client computer 112. See, e.g., Staples et al. Fig. 7 and paragraphs 142 – 166. Staples et al. describes the physical user phone 90 with reference to Figure 6. The physical user phone 90 operates through a “telephony client application 91 running on remote client computer **112** establishes the telephony connection  $C_t$  to telephony gateway 123 as shown in FIG. 6. Telephony client application 91 may automatically establish the telephony connection  $C_t$  when the remote user invokes (i.e. executes) telephony client application 91.” *Id* (emphasis added).

The Staples et al. telephony client application 91 is an important element of the Staples et al. invention. Specifically, “[t]elephony client 91 embeds the encoded voice data and control messages into a first stream of telephony packets (e.g. RTP packets) addressed for telephony gateway 123. Telephony client 91 transmits the first stream of telephony packets to telephony gateway 123 through the telephony connection  $C_t$ .” Paragraph 0139. Moreover, “the client

computer is configured to execute a **telephony client application**, wherein the telephony client application is configured to establish the first connection through the Internet to the telephony gateway.” Staples et al. claim 15 (emphasis added); *and see*, for example, claims 16 – 26, 92 – 97. Thus, connecting a physical user phone 90, if included, through the client computer 112 is an important element of the Staples et al. user communication device 130.

Therefore, connecting that physical user phone 90 directly to public telephone network 150, would render the telephony client 91 unsatisfactory for its intended purpose; and change a principal of Staples et al. operation, i.e., the intended purpose of the “[t]elephony client 91 [operation of embedding] the encoded voice data and control messages into a first stream of telephony packets (e.g. RTP packets) [from the physical user phone 1110] addressed for telephony gateway 123.” *Supra*.

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” MPEP §2143.03 VI. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” MPEP §2143.03 VI. Therefore, combining Staples et al. and Fenton et al. to result in the present invention is non-obvious and a straightforward combination fails to result in or suggest the present invention as recited in claims 1, 3, 6, 9, 15, 16 and 20 – 22. Reconsideration and withdrawal of the rejection of claims 1, 3, 6, 9, 15, 16 and 20 – 22 over Staples et al. and Fenton et al. under 35 U.S.C. §103(a) is respectfully requested.

With regard to claims 4, 5, 7, 8, 10, 11, 13, 14 and 23 – 25, Weinstein et al. adds nothing to the straightforward combination of Staples et al. and Fenton et al. to result in the present invention as recited in claims 1, 9, 15 and 20, from which claims 4, 5, 7, 8, 10, 11, 13, 14 and 23 – 25 depend. Therefore, the combination of Weinstein et al. with Staples et al. and Fenton et al. fails to result in the present invention, as recited in claims 4, 5, 7, 8, 10, 11, 13, 14 and 23 – 25. Reconsideration and withdrawal of the rejection of claims 4, 5, 7, 8, 10, 11, 13, 14 and 23 – 25 under 35 U.S.C. §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 3 – 11, 13 – 16 and 20 – 25 under 35 U.S.C. §103(a) and allow the application to issue.

The applicants have previously noted that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added.) The applicants continue to believe that the written description of the present application is quite different than and not suggest by any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

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